

#13

PATENT APPLICATION
Serial No. 09/432,811**PATENT APPLICATION**
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

David FELGER

Serial No. 09/432,811

Filed: November 4, 1999

For: METHOD OF BILLING A
PURCHASE MADE OVER A
COMPUTER NETWORK

Group Art Unit: 2761

Examiner: TBA

Attorney Docket No. 2416.84535

COMMUNICATION REGARDING PETITION TO MAKE SPECIALDirector of Patents
Washington, D.C. 20231

Dear Sir:

Applicant recently submitted a Status Inquiry for the above-captioned case. The Status Reply Letter Reply indicated that an Action by the Examiner was expected in September 2002.

In view of the length of time before an Action was expected, Applicant's representative contacted the Customer Service Office for Technology Center 2100 because a Petition To Make Special Under 37 C.F.R. § 1.102(d), a Declaration Of Joseph P. Curtin In Support Of Petition To Make Special Under 37 C.F.R. § 1.102(d), an Information Disclosure Statement and Form PTO-1449, the patents cited on the Form PTO-1449, and the requisite fee for the Petition were submitted to the Patent and Trademark Office on April 18, 2000. The Customer Service Representative indicated that the Petition, Declaration, Information Disclosure Statement, Form PTO-1449 and a



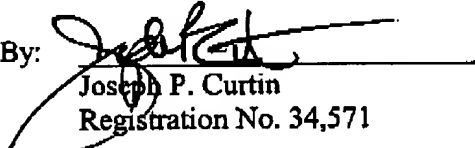
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date-stamped postcard for the Petition, Declaration, Information Disclosure Statement and Form PTO-1449 should be resubmitted so that the Petition can be considered and examination of the application can be accelerated. Copies of the patents cited in the Form PTO-1449 have not been resubmitted.

Accordingly, Applicant respectfully requests that the Petition to Make Special be granted and the application undergo accelerated examination.

Respectfully submitted,
BANNER & WITCOFF, LTD.

By:


Joseph P. Curtin
Registration No. 34,571

Banner & Witcoff, LTD.
1001 G Street, N.W., 11th Floor
Washington, D.C. 20001-4597
(202) 508-9100

Dated: October 10, 2001

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the U.S. Patent and Trademark Office on October 10, 2001, to (703) 746-7239 (20 Pages).


Sylvia Strickland

Official
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Patent/Design**HAND CARRY Group/Section** 2761☒ **PATENT** ☐ **DESIGN****Bldg** CPARK 2 **Rm** 6th Floor**Serial No.** 09/432,811 **B&W #** 02416.84535 **Atty/Sec** JPC?sgs **Date** 4/18/00**Inventor** David Felger **Client** NATIONAL PSYCHIC**Title** METHOD OF BILLING A PURCHASE MADE OVER A COMPUTER NETWORK

The following has been received in the U.S. Patent and Trademark Office on the date stamped hereon:

- ☐ total pp Spec., including: # of Claims
(# of independent claims); ☐ Abstract
- ☐ Foreign Priority on
Country, Appl. # and Date
- ☐ Priority on U.S. Prov. B&W#
- ☐ Application: ☐ CIP ☐ Continuation ☐ Divisional
Parent Ser. No. B&W#
- ☐ Provisional App pp Spec/Cims; Cover Sheet
- ☐ Declaration/PoA: ☐ Executed ☐ Unexecuted
- ☐ Drawings: ☐ Formal ☐ Informal
of distinct sheets ; Figs.
- ☐ Assignment w/PTO Cover Sheet
- ☐ Small Entity Declaration
- ☐ IDS w/PTO 1449 ☐ Prior Art ☐ w/fee
- ☐ Preliminary Amendment
- ☐ Response: Missing Parts dtd
- ☐ Request for Expedited Foreign Filing License
- ☐ Request for Corrected Filing Receipt
- ☐ Claim for Priority w/Priority Doc
Country, Appl. # and Date
- ☐ Petition for Extension of
- ☐ Amendment ☐ Responses
- ☐ Request for Approval of Drawing Changes
- ☐ CPA Request ☐ w/Ext of Term
- ☐ Notice of Appeal & Fee
- ☐ Brief: ☐ Appeal & Fee ☐ Reply
- ☐ Request for Oral Hearing
- ☐ Issue Fee: Allowance dtd
- ☐ Advance Patent Copies ☐ ordered
- ☒ Check # 150364 for \$ 130.00
- ☐ Check # for \$
- ☒ PETITION TO MAKE SPECIAL AND IDS
- ☒ 3 SHEETS OF FORM PTO-1449 AND COPIES
- ☒ OF ALL CITED PRIOR ART; EXECUTED
- ☒ DECLARATION OF JOE CURTIN IN SUPPORT
- THEREOF B&W Rev. 4/98

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PATENT APPLICATION**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of:)	HAND DELIVERY
)	Crystal Park 2 - 6th Floor
David FELGER)	
)	
Serial No. 09/432,811)	Group Art Unit: 2761
)	
Filed: November 4, 1999)	Examiner: TBA
)	
For: METHOD OF BILLING A)	Attorney Docket No. 2416.84535
PURCHASE MADE OVER A)	
COMPUTER NETWORK)	

PETITION TO MAKE SPECIAL UNDER 37 C.F.R. § 1.102(d)

Assistant Commissioner for Patents
Washington, D.C. 20231

ATTN: Mr. James Dwyer

Dear Sir:

This is a Petition to Make Special the above-identified patent application. The grounds and conditions for granting this application special status are found in MPEP 708.02 VIII entitled "Special Examining Procedure for Certain New Applications - Accelerated Examination."

A check for the amount of the Petition Fee, \$130.00, as required pursuant to § 1.17(i) is enclosed. Should any variance in fees exist, please charge or credit Deposit Account 19-0733. A duplicate of this sheet is attached.

As provided for in MPEP 708.02 VIII, Applicant agrees to the special examining procedure detailed therein. In support of this Petition, Applicant submits the Declaration of Joseph P. Curtin referring to:

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(a) The results of a pre-examination search which was made in connection with the invention;

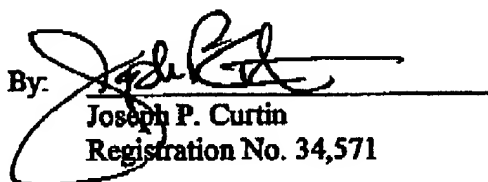
(b) Copies of each of the references found upon search deemed most closely related to the subject matter encompassed by the claims;

(c) A detailed discussion of the references, which discussion points out, with the particularity required by 37 C.F.R. § 1.111 (b) and (c), how the claimed subject matter is distinguishable over the references; and

(d) The agreement of the Applicant to limit examination of this application to one invention, encompassed by claims 1-70.

Accordingly, Applicant requests that this Petition to Make Special be granted and the application undergo accelerated examination.

Respectfully submitted,
BANNER & WITCOFF, LTD.

By: 
Joseph P. Curtin
Registration No. 34,571

Attachment: Declaration of Joseph P. Curtin

Banner & Witcoff, LTD.
1001 G Street, N.W., 11th Floor
Washington, D.C. 20001-4597
(202) 508-9100

Dated: April 18, 2000

PATENT APPLICATION
Serial No. 09/432,811

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:)	HAND DELIVERY
)	Crystal Park 2 - 6th Floor
David FELGER)	
)	
Serial No. 09/432,811)	Group Art Unit: 2761
)	
Filed: March 30, 1999)	Examiner: TBA
)	
For: METHOD OF BILLING A)	Attorney Docket No. 2416.84535
PURCHASE MADE OVER A)	
COMPUTER NETWORK)	

DECLARATION OF JOSEPH P. CURTIN IN SUPPORT OF
PETITION TO MAKE SPECIAL UNDER 37 C.F.R. § 1.102(d)

1. I am an associate of the firm of Banner & Witcoff, Ltd., and the attorney for the Applicant in the above-identified patent application. I am a registered Patent Attorney (Registration No. 34,571). I make this Declaration in support of Applicant's Petition to Make Special in the above-identified application.

2. The subject matter of the above-identified application relates to a method for billing a purchase made over a computer network.

3. To determine the patentability of the claims as submitted in the application, a thorough and careful pre-examination search was conducted in the United States Patent and Trademark Office in Class 379, subclasses 90.01, 91.01, 91.02, 93.02, 93.03, 93.12, 93.13, 93.27, 93.23, 93.25, 100.04, 118 and 119, after filing the application. This search was conducted by Thadius N. Fletcher, a professional patent searcher. The above class and subclasses are believed to be the most relevant to the invention in question.

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4. The patent search uncovered the following pertinent patents, copies of which are attached hereto:

U.S. Patent No. 3,920,908 to Kraus

U.S. Patent No. 4,567,359 to Lockwood

U.S. Patent No. 4,792,968 to Katz

U.S. Patent No. 5,003,584 to Benyacar et al.

U.S. Patent No. 5,023,904 to Kaplan et al.

U.S. Patent No. 5,181,238 to Medamana et al.

U.S. Patent No. 5,333,181 to Biggs

U.S. Patent No. 5,561,707 to Katz

U.S. Patent No. 5,715,314 to Payne et al.

U.S. Patent No. 5,724,424 to Gifford

U.S. Patent No. 5,828,734 to Katz

U.S. Patent No. 5,841,469 to Freeman et al.

U.S. Patent No. 5,875,236 to Jankowitz et al.

Our pre-examination search uncovered several patents related to the field of electronic or automated billing for goods and/or services acquired utilizing a telecommunications network or the like. The most relevant patents uncovered by our search appear to be U.S. Patent No. 5,724,424 to Gifford, U.S. Patent No. 5,715,314 to Payne et al., U.S. Patent No. 4,792,968 to Katz, U.S. Patent No. 5,181,238 to Medamana et al., and U.S. Patent No. 5,023,904 to Kaplan et al.

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U.S. Patent No. 5,724,424 to Gifford discloses a network sales system that allows a user to purchase goods or information over a computer network, such as the Internet. According to Gifford, the network sales system includes a plurality of buyer computers, a plurality of merchant computers and a payment computer that are interconnected by the computer network. A user at a buyer computer purchases a product and the buyer computer sends a purchase message to a merchant computer. The merchant computer constructs a payment order that it sends to the payment computer. The payment computer authorizes the purchase and sends an authorization message to the merchant computer. When the merchant computer receives the authorization message, product is sent to the buyer computer. Alternatively, the buyer computer can send a payment order directly to the payment computer, which, in turn, sends an authorization message back to the buyer computer that includes an unforgeable certificate indicating that the order is valid. The buyer computer then constructs a purchase message that is sent to the merchant computer. When the merchant computer receives the purchase request, the product is sent to the buyer computer based on the pre-authorized payment order.

U.S. Patent No. 5,715,314 to Payne et al. (Payne) discloses a similar network-based sales system that includes at least one buyer computer, at least one merchant computer and at least one payment computer that are interconnected by a computer network, such as the Internet. According to Payne et al., a merchant computer can respond to payment orders from a buyer computer without the merchant computer having to communicate directly with the payment computer for ensuring that the user is authorized to purchase the product and without the merchant computer having to store

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information in a database regarding which buyers are authorized to purchase which products. When the merchant computer receives an access message from the buyer computer identifying a product to be purchased, the merchant computer need only check the access message for ensuring that the access message was created by the payment computer, thereby establishing that the buyer is authorized to purchase the product.

U.S. Patent No. 4,792,968 to Katz (Katz '968) discloses an automated system for a mail order operation. According to Katz '968, the system prompts a caller for caller identification and payment information. Before requesting merchandise information, the caller identification and payment information is verified using a two stage process. First, the caller confirms the information. Then, the propriety of the information is checked by, for example, a negative list of unacceptable cards and customer's numbers.

U.S. Patent No. 5,181,238 to Medamana et al. (Medamana) relates to a system for authenticating callers seeking access to vendor-provided services. According to Medamana, a caller at a telephone station wishing to communicate with a terminal of a service provider dials the telephone number of the service provider. The telephone number of the telephone station from which the call is placed is identified by automatic number identification (ANI) facilities of a local telecommunications switching system. The call and ANI information are routed to a network services complex (NSC) for obtaining information necessary for performing authentication. The NSC prompts the caller to enter information, such as an account number, a PIN number, using DTMF digits keyed in by the caller. A service provider may choose to use the ANI number as the account number

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because both require verification via a correct PIN. When the account number and PIN information has been received, the NSC sends a request to a direct services dialing database network control point (DSD NCP) for obtaining the PIN and additional customer account information. The NSC uses the information returned from the DSD NCP to check whether the PIN supplied by the customer is correct. When the caller is seeking auxiliary services, the NSC then prompts the caller to enter an account number, such as a credit card number, for auxiliary service (e.g., credit) verification. The auxiliary service provider validates the account number and replies with a message indicating whether the transaction can proceed. The response from the auxiliary service provider may optionally include a dollar amount of credit available in the account. Depending on the response from the alternate service provider, the NSC denies the call or proceeds with call completion.

U.S. Patent No. 5,023,904 to Kaplan et al. (Kaplan) relates to an automated ordering service conducted by means of telephone lines wherein no voice communications is required. According to Kaplan, a Local Access and Transport Area (LATA) switching network provides automatic number identification (ANI) information of a calling customer to an order service office. Data processing equipment at the ordering service office receives and stores the incoming call with its 10 digits of information, as well as the ANI information identifying the vendor involved, the particular vendor's product and telephone number of the ordering customer. In this regard, the data processing equipment utilizes and processes certain digits for the call for determination of the variables, such as vendor and various product and/or service code designations.. The data processing equipment may

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be programmed with prerecorded customer-subscriber credit information for either accepting or rejecting the order or the information may be merely stored for future processing.

Each of Gifford, Payne, Katz '968, Medamana, and Kaplan fail to disclose or suggest a method of billing a purchase made over a computer network as recited in independent claim 1 in which it is first determined whether a user passes fraud control before effecting a sale over a computer network. Once the user passes the fraud control, information associated with a method of payment is requested from the user. The information associated with the method of payment is received from the user and a sale transaction is completed based on the received information associated with the method of payment. It is respectfully submitted that none of Gifford, Payne, Katz '968, Medamana and Kaplan either taken alone or in combination discloses or suggests a method of billing a purchase made over a computer network as recited in independent claim 1 in which it is first determined whether a user passes fraud control before effecting a sale over a computer network. Further, it is respectfully submitted that none of the other patents uncovered by the pre-examination search is any more relevant than the Gifford, Payne, Katz '968, Medamana and Kaplan patents. Based upon the prior art of record, the present invention appears to provide a novel and non-obvious method for billing a purchase made over a computer network.

The remaining eight patents, uncovered during the pre-examination search, are generally related to billing techniques for telephone calls and for purchasing products over a telephone network. It is respectfully submitted that each of the eight patents fail to disclose or suggest at least the concept of a purchase made over a computer network according to the present invention.

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U.S. 3,920,908 to Kraus relates to a method of and a credit center for expeditiously enabling one party to obtain a service on credit from another party when both parties are geographically separated. Predetermined signals originating at a calling set are recorded at a traffic service position system (TSPS) and utilized for activating a credit center to locate the calling set credit intelligence.

U.S. Patent No. 4,567,359 to Lockwood relates to a system for automatically dispensing information, services and products to customers in a self-service fashion. A data processing center is linked to several remote satellite facilities that are self-service sales and information terminals.

U.S. Patent No. 5,003,584 to Benyacar et al. (Benyacar) relates to a telecommunications billing method and apparatus for specifying and calculating the billing charges associated with value-added communication calls. According to Benyacar, a caller wishing to place a value-added call dials the telephone number of a desired service provider. The call is routed to an Equal Access End Office (EAEO) having an automatic number identification (ANI) capability. The ANI number is required for billing the calling party for calling charges and for any value-added services. If the call is recognized as a value-added call, an Operator Services Position System (OSPS) may automatically collect the caller's telephone or charge card number, or may connect an operator for collecting the caller's number. The caller's telephone number (ANI) and charge card number are used for billing charges incurred by the caller during the call. The card number information is forwarded to an action control point (ACP) for call processing and credit card validation. (Accordingly, some telephone credit card use ANI plus a PIN as the credit card validation.)

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U.S. Patent No. 5,333,181 to Biggs relates to a telephone system that has speed dial buttons and a billing information input device for accessing a plurality of amenities available through a central office switching device or carrier switch. The central office switching device can receive information from the telephone system in the form of a message that includes an origination number, a request for a specific service, a user's credit card number and expiration data, as well as other relevant data.

U.S. Patent No. 5,561,707 to Katz relates to a system that interfaces with a plurality of individual terminals of a telephone network facility. Callers at the terminals are prompted by voice-generated instructions to provide digital data that is identified for positive association with a caller and is stored for processing. A caller's identification data is confirmed using various techniques.

U.S. Patent No. 5,828,734 to Katz relates to a system for use with a public telephone network incorporating a plurality of terminals that limits and controls interface access for implementing voice-digital communication for statistical processing. The system accommodates calls in different modes, e.g., "800", "900" or area code and incorporates qualifying apparatus for restricting against caller misuse.

U.S. Patent No. 5,841,469 to Freeman et al. relates to a video conferencing network interconnected by a telephone network. Each terminal is activated only when the balance in a user account has been read and the account has been made available for debiting.

U.S. Patent No. 5,875,236 to Jankowitz et al. (Jankowitz) relates to an automated system for detecting and preventing fraudulent telephone calls in a telecommunications network. According to Jankowitz, when a toll call is attempted, a Network Access Interruption (NAI) database is accessed

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for determining whether the call is potentially a fraudulent call. The NAI database includes a Customer Account Table containing all line number, such as ANI, mobile identification number (MIN), 10 digit card number or dialed number, that are to receive NAI treatment, including customers who are denied credit or for whom selective blocking and/or thresholding are to be provided. If an account associated with a customer is, for example, delinquent, a credit deny indicator in the record for the account will be set. The NAI database transmits a deny response, signaling the network to terminate the call or to take other appropriate action.

5. In accordance with MPEP 708.02 VIII, Applicant hereby agree to restrict examination to claims 1-132 appearing in this application, which are directed to a single invention. However, if the Office determines that all of the claims presented are not obviously directed to a single invention, Applicant will make an election without traverse.

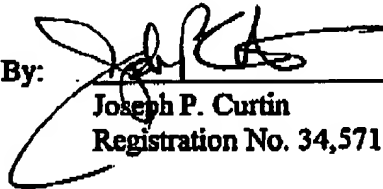
6. I further declare that all statements made herein of my own personal knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize that validity of the above-referenced application or any patent issuing thereon.

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Should the Examiner believe that any further action is necessary in order to place the application in condition for allowance, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

By:



Joseph P. Curtin
Registration No. 34,571

Attachment: Petition to Make Special

Banner & Witcoff, LTD.
1001 G Street, N.W., 11th Floor
Washington, D.C. 20001-4597
(202) 508-9100

Dated: April 18, 2000

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

David FELGER

Serial No.: 09/432,811

Filed: November 4, 1999

**For: A METHOD OF BILLING A PURCHASE
MADE OVER A COMPUTER NETWORK**

Group Art Unit: 2761

Examiner: TBA

Atty. Docket No.: 02416.84535

INFORMATION DISCLOSURE STATEMENT

**Honorable Assistant Commissioner for Patents
Washington, D.C. 20231**

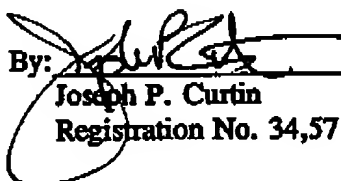
Sir:

Pursuant to 37 C.F.R. § 1.56, the attention of the Patent and Trademark Office is hereby directed to the reference(s) listed on the attached PTO-1449. One copy of each reference is attached. It is respectfully requested that the information be expressly considered during the prosecution of this application, and that the reference(s) be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

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The accompanying Information Disclosure Statement is being filed within three months of the U.S. filing date OR before the mailing date of a first Office Action on the merits. No certification or fee is required.

Respectfully submitted,
BANNER & WITCOFF, LTD.

By: 
Joseph P. Curtin
Registration No. 34,571

1001 G Street, N.W.
Eleventh Floor
Washington, D.C. 20001-4597
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Dated: April 18, 2000